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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/760,228	01/21/2004	Kia Silverbrook	WAL05US	2203

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AUSTRALIA

EXAMINER

COLILLA, DANIEL JAMES

ART UNIT	PAPER NUMBER
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2854

DATE MAILED: 11/09/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/760,228

Applicant(s)

SILVERBROOK ET AL.

Examiner

Daniel J. Colilla

Art Unit

2854

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 December 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2,4,5 and 7-17 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2,4,5 and 8-16 is/are rejected.
- 7) ☒ Claim(s) 7 and 17 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Double Patenting

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the “right to exclude” granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claims 1 and 8 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 8 of copending Application No. 10/962,399.

Although the conflicting claims are not identical, they are not patentably distinct from each other because claim 1 of Application No. 10/962,399 recites all the structure that is recited in claims 1 and 8 of the present application except that Application No. 10/962,399 does not explicitly recite a chassis. However, the recitation of “a rotating carousel of at least two slitter rollers rotatably held between the at least two end plates in” Application No. 10/962,399 recites structure that taken all together can be considered a chassis.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

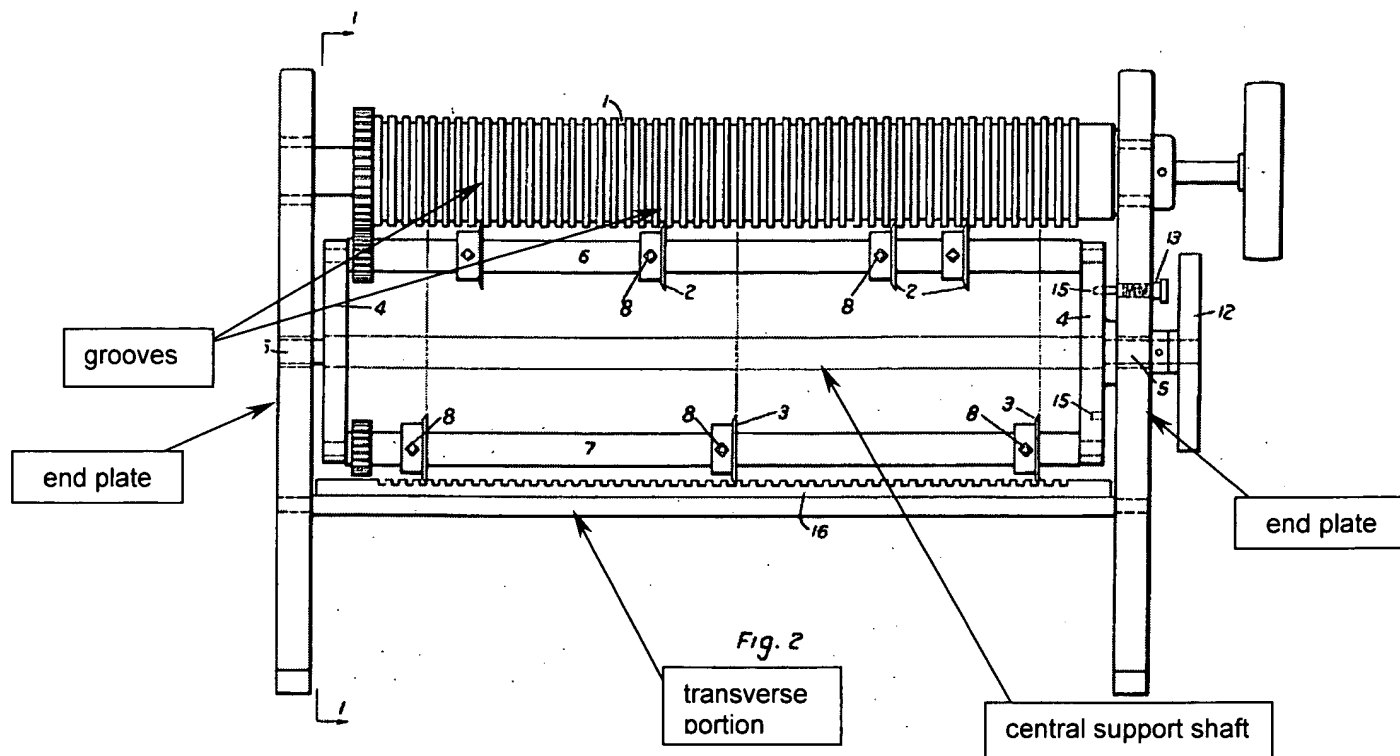
Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1 and 4-5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cameron et al. (US 1,570,940).

With respect to claim 1, Cameron discloses the claimed slitting mechanism except for the four rotating slitting shafts. Cameron et al. discloses a slitting mechanism including a chassis having end plates and a transverse portion as shown below in the Figure taken from Figure 2 of Cameron et al.:



Cameron et al. further discloses two rotating slitting shafts 6 and 7 extending between the end plates, each shaft having one or more slitters 2 and 3 respectively forming a rotating carousel arranged about a central support shaft. Each of the slitters have cutting edges as shown above. As shown above each slitter shaft 6 and 7 has at least one slitter 2 and 3, respectively, arranged along its length in a predetermined position different from those of the slitter of the other slitting shaft. The slitting mechanism can be selectively engageable to either enter or not enter a web path if a user so desires to move the above mechanism into or out of the path of a web. Although Cameron only discloses two rotating slitting shafts, the provision of two more rotating slitting shafts would have been obvious to one of ordinary skill in the art to provide more options of slitting spacing of the slitters.

With respect to claim 4, Cameron discloses a guide roller 1 which extends between the end plates except that it is not under the path of the media. Instead Cameron discloses a guide

Art Unit: 2854

roller above the path of the media as shown in Figure 2. Applicant is reciting a mere reversal of parts disclosed by Cameron. It has been held that reversal of parts would have been an obvious modification to one of ordinary skill in the art (In re Gazda, 219 F.2d 449, 104 USPQ 400 (CCPA 1955)). It would have been obvious to reverse the parts so that the slitter shafts 6 and 7 were above the guide roller 1 in order to make them more accessible for adjusting the slitters 2 and 3. Additionally, Cameron discloses that the guide roller has a number of circumferential grooves as shown in the Figure above; one slitter being associated with at least one groove.

With respect to claim 5, Figure 2 of Cameron shows that each shaft 6 and 7 is positionable such that each slitter 2 and 3, respectively enters a corresponding groove of the guide roller 1 when the selected shaft is rotated into a cutting position.

5. Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Cameron et al. (US 1,570,940) in view of Coburn (US 4,142,455) .

Cameron discloses a pair of rotating end brackets 4 between which extend the slitting shafts 6 and 7 and the support shaft as shown above. Cameron does not disclose a motor carried by one of the end plates for turning at least one of the brackets. Instead Cameron discloses a hand wheel for turning at least one of the brackets carried by an end plate. However, Coburn teaches a motor 61 (as shown in Figure 2 of Coburn) supported by an end plate 12 for rotating a slitter shaft. It would have been obvious to combine the teaching Coburn with the slitting mechanism disclosed by Cameron for the advantage of replacing manual power with electrical power.

Art Unit: 2854

6. Claims 8 and 10-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cameron et al. (US 1,570,940) as applied to claims 1 and 4-5 above, and further in view of Kwasny et al. (US2002/0118990) and Kawakami (JP 2000-15596).

With respect to claim 8, Cameron et al. discloses the claimed slitting mechanism except for the transverse cutter. However, Kwasny et al. teaches a slitting mechanism 16 and a transverse cutter 14 as shown in Figures 1-2 of Kwasny et al. the cutter 14 extends between end plates of the housing as shown in Figure 1. It would have been obvious to combine the teaching of Kwasny et al. with the slitting mechanism disclosed by Cameron et al. for the advantage of cutting in two directions, perpendicular to one another, so that a desired size of media can be achieved as shown in Figure 1A of Kwasny et al. It is not known to the examiner if the cutter 14 performs a cutting motion which begins on one side of the web and finishes on an opposite side of the web. However, Kawakami teaches a transverse cutter that begins cutting at one side and finishes at the other side as shown in Figure 4 of Kawakami. It would have been obvious to combine the teaching of Kawakami with the slitting mechanism disclosed by Cameron et al. for the advantage of cutting without moving the media being cut by use of pressing plate 68 (see lines 10-13 of the solution portion of the English abstract of Kawakami).

With respect to claims 10-11, each end of the blade is driven and carried eccentrically by a rotating member 18 that rotates as shown in Figures 1 and 4 (see paragraph [0033] of the machine translation of Kawakami).

Art Unit: 2854

7. Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Cameron et al. (US 1,570,940) in view of Kwasny et al. (US2002/0118990) and Kawakami (JP 2000-15596), as applied to claims 8 and 10-11 above, and further in view of Scott (US 2003/0033922).

Cameron et al. in view of Kwasny et al. and Kawakami discloses the claimed slitting mechanism except for the motor being supported by an end plate. Kawakami teaches a motor 15 coupled to a blade 25 that is supported by a back plate 3 as shown in Figure 1 of Kawakami. However, Scott teaches a motor 28 coupled to a blade 24 that is supported by an end plate as shown in Figures 4-5 of Scott. It has been established that the mere rearrangement of parts is an obvious matter of design choice (see MPEP § 2144.04, part VI, C). It would have been obvious to move the motor from the back plate to the end plate so that the motor attachment screws are on the same side as numerous other attachment screws 5 and 29 as shown in Figure 1 of Kawakami, thus expediting the manufacture of the apparatus.

8. Claims 12-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cameron et al. (US 1,570,940) as applied to claims 1 and 4-5 above, and further in view of Carter (EP 594306).

With respect to claim 12, Cameron et al. discloses the claimed slitting mechanism except for the pair of entry rollers. However, Carter teaches a slitting mechanism with a pair of entry rollers 41,42 (left-most pair) that are powered by a motor M as shown in Figures 5-6 of Carter. It would have been obvious to combine the teaching of Carter with the slitting mechanism disclosed by Cameron et al. for the advantage of individually adjustable slitting blades positionable anywhere along the width of the paper (Carter, col. 1, lines 42-52).

With respect to claim 13, Carter teaches exit rollers 41,42 (right-most pair) as shown in Figure 5 of Carter. These rollers are also powered by motor M as shown in Figure 6 of Carter.

9. Claims 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over Cameron et al. (US 1,570,940) in view of Carter (EP 594306), as applied to claims 12-13 above, and further in view of Coburn (US 4,142,455).

Cameron et al. in view of Carter discloses the claimed slitting mechanism as mentioned above but it is not known to the examiner if the motor M is carried by the chassis. However, Coburn discloses a motor 62 that is carried by a chassis. It would have been obvious to combine the teaching of Coburn with the slitting mechanism disclosed by Cameron et al. in view of Carter for the advantage of easy access to the motor for maintenance purposes.

10. Claims 15-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cameron et al. (US 1,570,940) in view of Carter (EP 594306) and Coburn (US 4,142,455), as applied to claim 14 above, and further in view of Yamaguchi (US 20030070753).

With respect to claim 15, Cameron et al. in view of Carter and Coburn discloses the claimed slitting mechanism except for the belt which passes around one each of the entry and exit rollers. Carter teaches a system of gears and belts for driving the entry and exit rollers 41,42 with a single motor M. Yamaguchi teaches entry and exit roller pairs 82a,82b and 83a,83b respectively. The rollers 82a and 83a are driven by a belt (not shown) as stated in paragraph [0122] lines 1-6 of Yamaguchi. It would have been obvious to modify Cameron et al. in view of Carter and Coburn to include the belt taught by Yamaguchi because belts and gears are well-

Art Unit: 2854

known basic mechanical expedients that are mechanical equivalents of one another. It is also noted that a motor inherently has a rotating shaft that is used to transmit the rotary power generated by the motor.

With respect to claim 16, it is not known to the examiner if Yamaguchi teaches a belt that is external to an end plate, however, Carter teaches a power transmitting belt external to an end plate 105 as shown in Figure 6 of Carter. It would have been obvious to combine this teaching of Carter with the slitting mechanism disclosed by Cameron et al., Coburn and Yamaguchi for the advantage or preventing interference of the power transmission belt with the moving parts of the slitting mechanism.

Allowable Subject Matter

11. Claims 7 and 17 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Response to Arguments

12. Applicant's arguments filed 12/22/05 have been fully considered but they are not persuasive of any error in the above rejection.

Applicant argues that Cameron et al. only teaches two slitting shafts instead of the four slitting shafts as is now recited in claim 1. However, as mentioned above, the provision of additional structure for carrying out the same function is an obvious matter.

Art Unit: 2854

13. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Daniel J. Colilla whose telephone number is 571-272-2157. The examiner can normally be reached on M-F 7:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Judy Nguyen can be reached at 571-272-2258. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 2854

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

October 30, 2006



Daniel J. Collita
Primary Examiner
Art Unit 2854